

Boehringer Ingelheim
Pharmaceuticals, Inc.

TO: Examiner Due Tan DATE: 7-30-03

1 _____

2 _____

3 _____

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FROM: Miriam A. Phillips



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,012	12/21/2001	Joshua Clapper	MSI-180	6071

28501 7590 07/23/2003

BOEHRINGER INGELHEIM CORPORATION
900 RIDGEBURY ROAD
P. O. BOX 368
RIDGEFIELD, CT 06877

EXAMINER

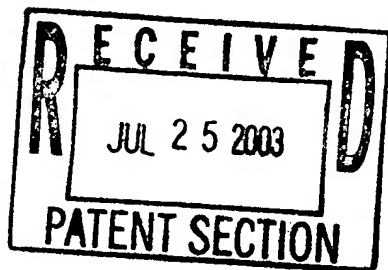
LE, QUE TAN

ART UNIT PAPER NUMBER

2878

DATE MAILED: 07/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



RECEIVED
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Office Action Summary

Application No.	Applicant(s)	
10/026,012	CLAPPER ET AL.	
Examiner	Art Unit	
Que T. Le	2878	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-21 is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

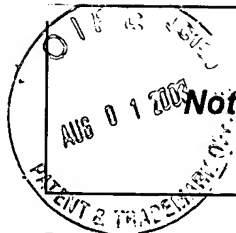
- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____.

**Notice of Ref rences Cited**

Application/Control No.

10/026,012

Applicant(s)/Patent Under
Reexamination
CLAPPER ET AL.

Examiner

Que T. Le

Art Unit

2878

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-3,761,620	09-1973	Graven, Robert M.	178/18.09
	B	US-3,937,558	02-1976	Mukai et al.	385/115
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

Form PTO-1449
U.S. Department of Commerce
Patent and Trademark Office

Docket No.

MS-180

Serial No.

Not Yet Known

INFORMATION DISCLOSURE
STATEMENT
IN AN APPLICATION

(Use several sheets if necessary)

Applicant

Joshua Clapper, Minura Topa, Pete Smith

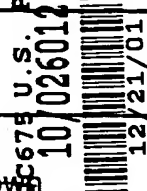
Filing Date

Herewith

12/21/01

Group Art Unit

Not Yet Known



U.S. PATENT DOCUMENTS

*EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
l	A	4,814,552	3/21/89	Stefik et al.	178	18	
l	B	5,113,244	5/12/92	Curran	385	24	
l	C	6,172,668	1/9/01	Baur	345	182	
l	D	4,777,329	10/11/88	Mallicoat	178	18	
l	E	5,818,421	10/6/98	Ogino et al.	345	157	
l	F	2,882,784	4/21/59	Toffolo			
l	G	6,151,015	11/21/00	Badyal et al.	345	179	
l	H	3,498,692	3/3/70	Jewitt et al.	350	96	
l	I	3,497,701	2/24/701	Dalton	250	216	
l	J	3,680,078	7/25/72	Baskin et al.	340	324	
l	K	4,109,146	8/22/78	Hillman	250	227	
l	L	4,184,044	1/15/80	Zwerenz	178	18	

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO

OTHER (Including Author, Title, Date, Pertinent Pages, Etc.)

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EXAMINER

Le

DATE CONSIDERED

7/03

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.

Art Unit: 2878

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3-13, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Mukai et al 3,937,558.

Mukai et al disclose an optical light pen system comprising: a housing (P); an optically conductive tip (C) for redirecting an optical signal; and an optically conductor (5) optically coupled to the tip, wherein the tip is in direct line of sight of one of the group consisting of at least one optical transmitter (L) and at least one optical receiver (D), and the optical conductor is in direct line of sight of the other one of the group consisting of the at least one optical transmitter and the at least one optical receiver. The axis of the tip is coaxial with the axis of the housing and optical signals are transmitted by the



Art Unit: 2878

transmitter are redirected to the receiver by the tip. The tip is able to redirect optical signals in a plurality of radial directions distributed around a longitudinal axis of the system. The tip and the conductor are integrally formed from a single piece of material.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukai et al 3,937,558.

With respect to claim 2, although Mukai et al fail to specify the particular material for making the tip and/or the conductor as claimed, selecting a specific material which has been known and available in the art for making a component/element would have been a mere matter of obvious design choice to one of ordinary skill in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mukai et al by selecting a specific material, as claimed, in order to provide a desired appearance of the system.

With respect to claim 14, although Mukai et al lack an inclusion of an ultrasonic transducer, the use of a known, available ultrasonic transducer for providing vibration would have been obvious to one of ordinary skill in the art. It would have been obvious to one of ordinary skill in the art to modify Mukai et al accordingly in order to provide vibration for the system if so desired.

With respect to claim 15, although Mukai et al fail to specify the type of the light source, the use of a light emitting diode or a laser diode for providing light would have been obvious to one of ordinary skill in the art. It would have been obvious to one of ordinary skill in the art to modify Mukai et al accordingly in order to provide a long lasting life of the use of the light source.

Claims 18-21 are allowable over the prior art of record because the prior art fails to teach a system for determining the position of a stylus comprising: a fixed transceiving portion for transceiving ultrasonic and optical signals, in which the transceiving portion including at least one ultrasonic transducer, and at least one optical transmitter and one optical receiver; an ultrasonic transducer including a single optical transmitter and a single optical receiver, wherein a position of the stylus is determined in accordance with the optical signals and propagation times of the ultrasonic signals.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

I) Graven 3,761,620 discloses an optical input system having light conductors.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Que T. Le whose telephone number is (703) 308-4830.

Art Unit: 2878

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Que T Le
Primary Examiner
Art Unit 2878